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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Yoshiharu Hino

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4828

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EXAMINER

LEE, SEUNG H

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n N .	Applicant(s)	
	09/769,293	HINO ET AL.	
	Examin r	Art Unit	
	Seung H Lee	2876	

-- The MAILING DATE f this c mmunicati n appears n the cover sheet with the correspondence address --
Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>01/16/2001</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Prelim. Amdt./Amendment

2. Receipt is acknowledged of the Preliminary Amendment filed on 28 July 2000.

Claim Objections

3. Claims 10, 11, 12 and 13 are objected to because of the following informalities:

Re claim 10, line 3: "said insertion recess" lacks proper antecedent basis. Please substitute "said insertion recess" with --an insertion recess--,

Re claim 11, line 3: "said insertion recess" lacks proper antecedent basis. Please substitute "said insertion recess" with --an insertion recess--,

Re claim 12, line 3: "said first module-side antenna" lacks proper antecedent basis. Please substitute "said first module-side antenna" with --a first module-side antenna--,

Re claim 12, line 5: "said second module-side antenna" lacks proper antecedent basis. Please substitute "said second module-side antenna" with --a second module-side antenna--,

Re claim 12, line 6: Please substitute "the first module-side antenna" with --said first module-side antenna--,

Re claim 12, line 7: Please substitute "the second module-side antenna" with --
said second module-side antenna--,

Re claim 13, line 3: "said first module-side antenna" lacks proper antecedent
basis. Please substitute "said first module-side antenna" with --a first module-side
antenna,

Re claim 13, line 4: "said second module-side antenna" lacks proper antecedent
basis. Please substitute "said second module-side antenna" with --a second module-
side antenna.

Appropriate clarification is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

5. Claims 7 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being
indefinite for failing to particularly point out and distinctly claim the subject matter which
applicant regards as the invention.

The phrase "said accessed object is an information recording medium" is vague
and indefinite to the Examiner wherein the accessed object such as a cartridge case is
used recording information or the accessed object is holding/receiving an information
recording medium. The Examiner interprets the claims 7 and 14 as the accessed object
is holding/receiving the information recording medium therein.

Appropriate clarification is required.

6. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "wherein said first module-side antenna secures an antenna effective area by coming face-to-face relation with a first apparatus-side in a first usage mode of communication apparatus to communicate with said accessed object" in claim 8 is unclear. It is vague and indefinite to the examiner what the applicant is intending to describe of that the first module-side antenna, that is, what is the first apparatus-side securing relation with the first module-side antenna by coming face-to-face relation? The examiner interprets "a first apparatus-side" as --a first apparatus-side antenna--.

Re claim 8, line 13: The phrase "said apparatus-side antenna" is vague and indefinite to the examiner what the applicant is intending to describe of that the apparatus-side antenna, that is, the apparatus-side antenna is the first apparatus-side antenna or the second apparatus-side antenna?

Appropriate clarification is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Maloney (US 6,204,764).

Maloney teaches an object tracking system comprising a container (41) serving as an accessed object wherein the container including a radio frequency identification (RFID) tag (52) serving as a non-contact IC module in which the RFID tag comprises an IC chip (53) and antenna (54 and 56), the antenna is extended from a bottom side (43) to a hinge cover (47) and/or a back cover (48) of the container, the RFID tag is in the form of adhesive stamps or stickers in which the RFID tag is flexible and is bent to attach to the inside of container (see Figs. 1-4; col. 6, line 12- col. 7, line 46).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6, 7, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of Sanders (US 6,276,523).

The teachings of Maloney have been discussed above.

Although, Maloney teaches the container having antenna thereon, he fails to particularly teach or fairly suggest that the container is a translucent and the container is an information recording medium.

However, Sanders teaches a compact disc container can be constructed of opaque plastic materials for holding information recording medium such as a compact disc (see Figs. 1a and 1b; col. 10, lines 25-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Sanders to the teachings of Maloney in order to provide convenience to user(s) wherein user(s) can verify the contents of the container without physically opening the container in which the container is holding the information recording medium such as a compact disc.

11. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of Brady et al. (US 6,441,740)(hereinafter referred to as 'Brady').

The teachings of Maloney have been discussed above.

Although, Maloney teaches the container having antenna thereon, he fails to particularly teach or fairly suggest that the container comprises a insertion slit.

However, Brady teaches a container (150) comprising a cavity for receiving a radio frequency transponder (100) wherein the cavity serves as a insertion slit (see Figs. 1 and 10; col. 4, line 56-col. 7, line 33).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to install the radio frequency transponder of Brady to the teachings

of Maloney in order to provide an alternative method of identifying of the object in case of malfunctioning of the RFID tag by using the additional radio frequency transponder installed on the object therewith.

12. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of Bashan et al. (US 6,719,206)(hereinafter referred to as 'Bashan').

The teachings of Maloney have been discussed above.

Although, Maloney teaches the container comprising a RFID tag having antenna thereon, he fails to particularly teach or fairly suggest that the RFID tag comprises a first module-side antenna a second module-side antenna.

However, Bashan teaches a chip carrier module wherein the chip carrier module comprises a substrate (21) having a first coil antenna (40) mounted on the lower surface of the substrate and a second coil antenna (41) is mounted on the upper surface of the substrate wherein the first antenna and the second antenna is connected through hole (43) to be wired to the integrated circuit (30) (see Fig. 7; col. 7, lines 6-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the RFID tag of Maloney with the chip carrier module of Bashan in order to provide an improved system for achieving enhanced communication performance by providing double antenna therewith.

Additional Remarks

13. The lack of an art rejection with this Office action is not an indication of allowable subject matter (i.e., even though the claim 8 is rewritten or amended to overcome the Claim rejections as discussed above). The disclosure/claimed language is such that it is impractical to conduct a reasonable search of the prior art by the Examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure;

Rodgers et al. [US 6,340,932] discloses a carrier with an antenna for radio frequency identification.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (571) 272-2401. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax-phone number for this group is (703) 872-9306.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [seung.le @uspto.gov].

*All Internet e-mail communications will be made of record in the application file.
PTO employees do not engage in Internet communications where there exists a*

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possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.


Seung H. Lee
Art Unit 2876
April 16, 2004


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800